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OFFICE OF PETITIONS

In re Application of
Guangyi Wang et al
Application No. 09/697,545
Filed: October 25, 2000
Attorney Docket No. 100848.213001US4

:DECISION ON PETITIONS
:UNDER 37 CFR 1.78(a)(3) AND
:37 CFR 1.53(e) TO ACCORD
:A FILING DATE
:

This is a decision on the communication filed December 4, 2002, which is being treated as a petition under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications noted in the amendment submitted concurrently with the instant petition. The communication is also being treated as a petition under 37 CFR 1.182 to accord a filing date of October 25, 2000 to the instant application.

The petition under 37 CFR 1.78(a)(3) is dismissed as moot.

The petition under 37 CFR 1.182 to accord the above-identified application a filing date of October 25, 2000 is granted.

On October 25, 2000, applicant submitted a transmittal letter for the filing of a continuing application under the provisions of 37 CFR 1.53(b), along with a preliminary amendment containing claims 1-20. This submission did not include a specification or drawings, but did include a preliminary amendment containing claims 1-20. Accordingly, on January 17, 2001, the Office mailed a Notice of Incomplete Nonprovisional Application which stated that the filing date would be the date of receipt of the specification, including at least one claim as prescribed by 35 U.S.C. § 112. No reply having been received, a Notice of Termination of Proceedings under 37 CFR 1.53(e) was mailed on October 4, 2002 and \$580 of the \$710 filing fee was refunded and \$130 was retained for the handling fee.

On December 4, 2002, applicant submitted the instant petition and a copy of a specification, claims and drawings, presumably from prior-filed Application No.

08/552,363, as noted in the accompanying declaration. Since petitioner asserts that the Notice mailed on January 17, 2001 was never received, a copy thereof accompanies this decision on petition to complete petitioner's records.

It is noted that the transmittal letter for the instant 37 CFR 1.53(b) application received on October 25, 2000 includes an incorporation by reference statement of the entire disclosure of the prior-filed application (No. "09/766,991" [sic, 08/766,991]. Although the incorporation by reference statement includes the wrong series code for the prior-filed application, it is clear that the correct application is Application No. 08/766,991. Therefore, in view of the incorporation by reference statement, on petition under 37 CFR 1.182, the typographical error in the series code will be excused, and, likewise, the USPTO will excuse the delay in filing the specification and drawings in this application, which were already on file as of the filing date accorded this application. As noted in MPEP 201.06(c), the incorporation by reference practice for continuing or divisional applications is only intended as a safeguard to permit the entry of a portion of the referenced incorporated prior application into the host application; not, as here, the entire specification and drawings of the referenced prior application, for which a petition under 37 CFR 1.182 and fee is required. See MPEP 201.06(c)(A).

Turning next to the petition under 37 CFR 1.78(a)(3), a petition under this section is only appropriate if the application was filed on or after November 29, 2000. The instant application was filed on October 25, 2000. Therefore, the petition is dismissed as involving a moot issue.

It is noted that the amendment submitted concurrently with the instant petition makes an incorporation by reference of all the prior-filed applications noted therein. The incorporation by reference statement in the transmittal letter submitted on October 25, 2000 only applies to prior-filed nonprovisional Application No. 09/766,991 [sic, 08/766,991] and, therefore, is only applicable to that application.

Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject

matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

Thus, no other applications can properly be incorporated by reference herein by any amendment filed after October 25, 2000, without *prima facie* raising the issue of new matter. Accordingly, a substitute amendment should be submitted which deletes the incorporation by reference statement for any prior application but 08/766,991.

The petition was accompanied by a \$740 filing fee; however, since \$580 of the initial filing fee was returned and \$130 retained for the handling fee, only \$580 of the \$740 filing fee submitted is due. Accordingly, petitioner's deposit account will be credited \$160 for the overpayment in the basic filing fee. The \$130 fee submitted for the instant petition will not be refunded since it was necessary in order to obtain the October 25, 2000 filing date for the instant application.

This application will be forwarded to the Office of Initial Patent Examination Division for processing as a 37 CFR 1.53(b) application with a filing date of October 25, 2000, with the copy of the specification, claims, drawings and declaration supplied on December 4, 2002.

Any questions concerning this decision on petition should be directed to Frances Hicks at (703) 305-8680.



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